REMARKS

Claims 1-3 were previously pending. New claims 19-21 have been added. Descriptive support for the new claims can be found at least by the descriptions on page 18, third paragraph of the specification. No new matter has been introduced.

The specification has been amended to correct a translational error. Descriptive support can be found in the PCT publication, WO 2005/037899, page 1, second paragraph. No new matter has been introduced.

Claim Rejections under 35 U.S.C. §112

The Office Action rejects claims 1-3 as being indefinite under 35 U.S.C. §112, second paragraph on the grounds that the phrase "tensioning ratio" is vague and indefinite. Applicants respectfully traverse the rejections.

The heat-shrinkable polyester films according to claims 1-3 are made by a process wherein the heat setting of the film is performed after the first stage of drawing in a state of tension. A person of ordinary skill in the art would understand that after the heat setting with tension, the film width would increase compared with the film width after the first stage of drawing, *i.e.*, before the heat setting. The phrase "tensioning ratio" indicates a ratio of the increase in the film width after the heat setting with respective to the film width before the heat setting, *i.e.*, after the first stage of drawing. In page 81, lines 1-4 of the specification, it is stated that "In table 3 ... a tensioning ratio in heat setting represents a ratio to a film width after the first stage of drawing." Table 3 shows a tensioning ratio of "3%" in the heat setting for Film Nos. 1-3, 5-8, and 10-11. Based on these disclosures, the person would understand that the sentence in page 81, lines 1-4 of the specification meant "In table 3 ... a tensioning ratio in heat setting represents a ratio of the [increase in] the film width after the heat setting with respect to the film width after the first stage of drawing." Therefore, the phrase "tensioning ratio" is clear and unambiguous. Withdrawal of the indefiniteness rejections is respectfully requested.

Claim Rejections under 35 U.S.C. §103

Claim 1 was rejected as allegedly being obvious under 35 U.S.C. §103(a) over Ito, WO 2003/091004 (English equivalent US 2006/0057346) in view of Sakamoto et al. (US 5,061,571); claim 2 was rejected as allegedly being obvious under 35 U.S.C. §103(a) over Ito in view of Sakamoto, and further in view of Boseki (JP 2002-331581); claim 3 was rejected as allegedly being obvious under 35 U.S.C. §103(a) over Ito in view of Sakamoto, and further in view of Hayakawa et al. (WO 02/087853, English equivalent US 2003/0165658) and further in view of Ito[1]. Applicants respectfully traverse the rejections.

Applicants respectfully submit that the primary reference, Ito (WO 2003/091004), is not prior art against the present application. Claim 1 is described and enabled by the priority document JP 2003-364532 filed October 24, 2003 and thus has an effective filing date of October 24, 2003. Similarly, claims 2 and 3 have an effective filing date of October 22, 2003 and October 21, 2003, respectively, based on an enabling disclosure of the subject matter of claim 2 in the priority document JP 2003-362192 filed October 22, 2003 and an enabling disclosure of the subject matter of claim 3 in the priority document JP 2003-361084 filed October 21, 2003. Applicants enclose herewith machine translations of the priority documents JP 2003-364532, JP 2003-362192, and JP 2003-361084. The present application is a 371 national phase application of PCT/JP2004/015859 filed October 20, 2004. Ito (WO 2003/091004) is **not** 102(b) prior art because Ito (WO 2003/091004) was published on November 6, 2003, less than one year prior to the international filing date of PCT/JP2004/015859, which is also deemed the filing date in the U.S., of the present application. Ito (WO 2003/091004) is **not** 102(a) prior art because Ito (WO 2003/091004) was published after the effective filing dates of present claims 1-3. Also, Ito (WO 2003/091004) is not 102(e) prior art because WO 2003/091004 was not published in English. Therefore, Ito (WO 2003/091004) is not prior art against claims 1-3. Withdrawal of the obviousness rejections of claims 1-3 over Ito (WO 2003/091004) in view of other references is respectfully requested.

---

[1] The recitation of "further in view of Ito" in page 6, paragraph 10, line 4 of the Office Action appears to be an error since Ito is already cited as

Double Patenting Rejections

I. Claim 1 was rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of US 7,279,204 ("the '204 patent") in view of Sakamoto. Applicants transverse the rejection.

The film of claim 1 of the '204 patent in view of Sakamoto would not have all the limitations, in particular, requirements (D) and (E), of present claim 1. The Office Action acknowledges that the '204 patent fails to disclose (D) and (E). The heat shrinkable polyester film of present claim 1 comprises a lubricant in the range of **0.02 to 0.5 mass %** and satisfies requirements (D) and (E). When the amount of the lubricant was outside the claimed range, a film with excellent blocking resistance, transferring property, and tear resistance could not be obtained (see Table 2 and Table 5 of the present application). On the other hand, claim 1 of the '204 patent does not recite a lubricant in the range of **0.02 to 0.5 mass %** and the film of claim 1 of the '204 patent would not satisfy requirements (D) and (E).

The Office Action relies on Sakamoto for the disclosure of a polyester film containing inorganic particles (page 9, second last paragraph). Applicants contend that the Office Action fails to establish reasonable expectation of success in using the inorganic particles of Sakamoto in the film of claim 1 of the '204 patent because an ordinary skill in the art would understand that the film of Sakamoto, a biaxially oriented polyester film useful as a base film for a magnetic tape etc. (see abstract), was different from the heat-shrinkable polyester film of claim 1 of the '204 patent.

For at least these reasons, applicants request withdrawal of the nonstatutory obviousness-type double patenting rejection of claim 1 over claim 1 of US 7,279,204 in view of Sakamoto.

II. Claim 2 was rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of the '204 patent in view of Sakamoto, in view of Boseki. Applicants traverse the rejection.

The film of claim 1 of the '204 patent in view of Sakamoto would not have all the limitations, in particular, requirements (F) and (G), of present claim 2. The Office Action

---

the primary reference in this ground of rejection.

acknowledges that the '204 patent fails to disclose requirements (F) and (G). In order to produce a heat-shrinkable polyester film that satisfies requirements (F) and (G), an ultraviolet radiation cutting agent should be used. Because the '204 patent fails to disclose the use of an ultraviolet radiation cutting agent, the film of claim 1 of the '204 patent would not meet the requirements (F) and (G), as recited in present claim 2.

The Office Action relies on Sakamoto for the disclosure of a polyester film containing inorganic particles and on Boseki for the disclosure of requirements (F) and (G) (page 10, first paragraph). Applicants contend that the Office Action fails to establish reasonable expectation of success in modifying the film of claim 1 of the '204 patent in view of the disclosures of Sakamoto and Boseki because an ordinary skill in the art would understand that the film of Sakamoto, a biaxially oriented polyester film useful as a base film for a magnetic tape etc. (see abstract), was different from the heat-shrinkable polyester films of claim 1 of the '204 patent or Boseki.

For at least these reasons, claim 2 would not have been obvious over claim 1 of the '204 patent in view of Sakamoto, in view of Boseki. Withdrawal of the double patenting rejection is respectfully requested.

III. Claim 3 was rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of the '204 patent in view of Sakamoto, in view of Hayakawa. Applicants traverse the rejection. Requirements (a)-(c) of instant claim 3, which recite the **average** heat shrinkage percentage for a **plurality** of samples and the heat shrinkage percentage difference ΔX of **each pair** of a **plurality** of sample pairs, are different from requirements (A)-(C) of claim 1 of the '204 patent, which do **NOT** involve a **plurality** of samples or sample pairs. The deficiency of claim 1 of the '204 patent is not cured by Sakamoto or Hayakawa because neither Sakamoto or Hayakawa teaches or suggest heat-shrinkable polyester film wherein the **average** heat shrinkage percentage for a **plurality** of samples and the heat shrinkage percentage difference ΔX of **each pair** of a **plurality** of sample pairs satisfy requirements (a)-(c), as recited in present claim 3. Therefore, the film of claim 1 of the '204 patent in view of Sakamoto and Hayakawa would not have all the limitations of instant claim 3. Claim 3 would not have been obvious over claim 1 of the '204 patent in view of Sakamoto, in view of Hayakawa. Withdrawal

of the double patenting rejection is respectfully requested.

CONCLUSION

If the filing of this response is deemed not timely, Applicants petition for an appropriate extension of time.

The Examiner is invited to contact the undersigned at (202) 220-4200 to discuss any matter concerning this application. The Office is authorized to charge any fees or credit any overpayments related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,
KENYON & KENYON LLP

Dated: September 22, 2010

By: /Qi Zhao/
Qi Zhao
Reg. No. 64,129

1500 K Street, N.W., Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201

Enclosures:

1. Request for Continued Examination (RCE)
2. English translation of priority document JP 2003-364532
3. English translation of priority document JP 2003-362192
4. English translation of priority document JP 2003-361084